

Appl. No. 09/867,058
Attorney Docket No. 98P7511US01
Amdt dated September 25, 2009
Reply to Office Action dated August 04, 2009

REMARKS AND ARGUMENTS

Applicants respectfully request entry of the amendments herein, and reconsideration and allowance of all of the claims of the application. The remarks and amendments should be entered under 37 CFR. § 1.116 as they place the application in better form for appeal, or for resolution on the merits.

Claims 1-20, 27 and 28 are presently pending. Claims amended herein are 1, 13, 14, 16 and 27. No claims are withdrawn, cancelled or added herein.

Claim Amendments

Without conceding the propriety of the rejections herein and in the interest of expediting prosecution, Applicants amend claims 1, 13, 14, 16 and 27 herein. Applicants amend claims to clarify claimed features. Such amendments are made to expedite prosecution and more quickly identify allowable subject matter. Such amendments are merely intended to clarify the claimed features, and should not be construed as further limiting the claimed invention in response to the cited references.

Support for the amendments to claims 1 and 27 are found in the original Specification at least at page 14 lines 5-12. Amendments to the claims are fully supported by the Specification and therefore do not constitute new matter.

SUBSTANTIVE MATTERS

Claim Rejections under § 112, second paragraph

The Examiner rejects claims 1, 13, and 27 under § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention.

In particular, the Examiner indicates (Action p. 2) that claims 1, 13, and 27 line 11 recites "... if said notification message" is unclear and confusing as it is not clear if this message refers to one of the "plurality of notification messages" in line 6 or the "notification message" in line 10. Without conceding the propriety of the rejections herein and in the interest of expediting prosecution, Applicants herein amend claims 1, 13, and 27 to recite "if said one of the plurality of notification messages."

With respect to claim 27 line 7, the Examiner further indicates that the phrase "said one or more messages" is unclear and confusing as to whether it refers to the "one or more messages" from line 3 or the "plurality of notification messages" in line 5. Without conceding the propriety of the rejections herein and in the interest of expediting prosecution, Applicants herein amend claim 27 lines 4 and 9 to recite "one or more received messages," which make it clear that it is referring to the "one or more messages" from line 3.

Accordingly, Applicants respectfully ask the Examiner to withdraw this rejection to these claims.

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Claim Rejections under 35 USC § 102 and/or §103

The Examiner rejects claims 1-12, 17-20 and 27-28 under § 102. In addition, the Examiner rejects claims 13-16 under § 103. The Examiner's rejections are based upon the following reference:

- **Mohler** : *Mohler*, US Patent No. 5,506,872.

For the reasons set forth below, the Examiner has not shown that the cited reference anticipates the rejected claims. In addition, the Examiner has not made a *prima facie* case showing that the rejected claims are obvious. Accordingly, Applicants respectfully request that the § 102 and/or § 103 rejections be withdrawn and the case be passed along to issuance.

Anticipation Rejections

Applicants submit that the anticipation rejections are not valid because, for each rejected claim, no single reference discloses each and every element of that rejected claim. Furthermore, the elements disclosed in the single reference are not arranged in the manner recited by each rejected claim.

Based upon Mohler

The Examiner rejects claims 1-12, 17-20 and 27-28 under 35 U.S.C. § 102(b) as being anticipated by Mohler. Applicants respectfully traverse the rejection of these claims. Based on the reasons given below, Applicants ask the Examiner to withdraw the rejection of these claims.

Independent Claim 1

Applicants are unable to find, in Mohler, any disclosure, teaching or suggestion of at least the following elements:

- “a message transmittal unit configured to automatically enable a plurality of notification messages to be generated across multiple user specified media and serially sent to a plurality of locations including at least one email address in response to said capacity calculator determining that the amount of space occupied by said one or more messages exceeds a predetermined threshold”
- “wherein a notification message is sent to a subsequent one of the plurality of locations if said one of the plurality of notification messages has not been received and responded to by an authorized user at a previous one of the plurality of locations”

The present claim relates to a multimedia message system that uses various techniques, such as facsimile, electronic mail (E-mail), telephone call and pager call, to notify the user of a full mail box condition. One of the advantages of generating notification messages across multiple user specified media is that it greatly increases the probability that the user is notified of the full mail box condition. This is important as the full mailbox condition may cause important messages to be unaccepted and callers to be turned away. In such situation, callers are not only not allowed to save messages, but they also may have no other means of contacting the user.

In contrast, Mohler describes a compression-rate selection arrangement that dynamically trades off capacity against signal quality by sacrificing capacity in favor of signal quality whenever capacity is plentiful and sacrificing quality in favor of capacity whenever capacity is scarce. See, for example, Mohler at Abstract. The purpose of Mohler's technology is quite different from that of the present Application, and therefore various presently claimed elements have been found entirely missing from the disclosure of Mohler.

For example, Applicants were unable to find in Mohler any disclosure, teaching or suggestion of serially sending notification messages to a plurality of locations including at least one email address. At most, Mohler describes cascading out-calling "so that a whole sequence of *numbers* is contacted in series until a *call* actually gets through." See Mohler at Col. 6 lines 28-31. Indeed, only telephone numbers, not email addresses, appear to be cascaded. Providing notification via email advantageously ensures that the user is notified even if he is traveling on the road and has no mobile phone reception in the vicinity and/or no access to telephones.

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In addition, Applicants are unable to find in Mohler "wherein a notification message is sent to a subsequent one of the plurality of locations if said one of the plurality of notification messages has not been *received and responded to by an authorized user* at a previous one of the plurality of locations." As discussed in the present Application (at p. 9 line 13 to p. 10 line 3), this feature advantageously prevents an unauthorized or inadvertent user from turning off or canceling the notification system. Mohler merely describes contacting a sequence of numbers "**until a call actually gets through**" but does not disclose checking or verifying the identity of the call recipient to ensure that the call recipient is an **authorized user**.

Consequently, Mohler does not disclose all of the elements and features of this claim. Accordingly, Applicants respectfully ask the Examiner to withdraw the rejection of this claim.

Dependent Claims 2-12 and 17-20

These claims ultimately depend upon independent claim 1. As discussed above, claim 1 is allowable. It is axiomatic that any dependent claim which depends from an allowable base claim is also allowable.

Additionally, some or all of these claims may also be allowable for additional independent reasons. For example, with respect to claim 8, Mohler also fails to disclose a non-volatile memory device including a **flash memory**.

Consequently, Applicants respectfully request the withdrawal of the rejections to these claims.

Independent Claim 27

Applicants submit that Mohler does not anticipate this claim because it does not disclose the following elements as recited in this claim (with emphasis added):

- “automatically enabling a plurality of notification messages to be generated across multiple user specified media and serially sent to a plurality of locations including at least one email address in response to determining that the amount of space occupied by said one or more received messages exceeds a predetermined threshold”
- “determining if the user who received the at least one notification message is authorized”
- “wherein a notification message is sent to a subsequent one of the plurality of locations if said one of the plurality of notification messages has not been received by an authorized user at a previous one of the plurality of locations”

As discussed above, Applicants respectfully submit that Mohler fails to disclose, teach or suggest serially sending notification messages to a plurality of locations including at least one email address. Mohler appears to only describe cascading telephone numbers, and not email addresses. As discussed previously, providing notification via email advantageously ensures that the user is notified even if he is traveling on the road and has no mobile phone reception in the vicinity and/or no access to telephones.

In addition, Applicants are unable to find, in Mohler, the features of “determining if the user who received the at least one notification message is authorized” and “wherein a notification message is sent to a subsequent one of the plurality of locations

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if said one of the plurality of notification messages has not been received by an authorized user at a previous one of the plurality of locations.” As discussed above, Mohler merely describes contacting a sequence of numbers “until a call actually gets through” but does not disclose checking or verifying the identity of the call recipient to ensure that the call recipient is an authorized user.

Consequently, Mohler does not disclose all of the elements and features of this claim. Accordingly, Applicants respectfully ask the Examiner to withdraw the rejection of this claim.

Dependent Claim 28

This claim ultimately depends upon independent claim 27. As discussed above, claim 27 is allowable. It is axiomatic that any dependent claim which depends from an allowable base claim is also allowable. Additionally, claim 28 may also be allowable for additional independent reasons.

Obviousness Rejections

Lack of Prima Facie Case of Obviousness (MPEP § 2142)

Applicants respectfully disagree with the Examiner's obviousness rejections. Arguments presented herein point to various aspects of the record to demonstrate that all of the criteria set forth for making a prima facie case have not been met.

Based upon Mohler

The Examiner rejects claims 13-16 under 35 U.S.C. § 103(a) as being unpatentable over Mohler. Applicants respectfully traverse the rejection of these claims and ask the Examiner to withdraw the rejection of these claims.

Applicants respectfully submit that the application of Official Notice in this Action is improper. With respect to Official Notice, the MPEP clearly states that "such rejections should be judiciously applied." See MPEP § 2144.03 (emphasis added). It is never appropriate to rely solely on "common knowledge" in the art without evidentiary support in the record, as the principal evidence upon which a rejection was based.

Zurko, 258 F.3d at 1385, 59 USPQ2d at 1697. See MPEP § 2144.03(A).

Applicants note that contrary to the caution advised by the MPEP, in this case, the Examiner has liberally applied Official Notice to at least four claims for various conclusory reasons that are not supported by the record. For example, with respect to claim 13, the Examiner appears to be taking Official Notice of the feature "wherein at least one of said plurality of notification messages includes changing the cadence of a message waiting light on a telephone associated with the mailbox." In addition, with respect to claim 14, the Examiner appears to be taking Official Notice of the feature

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“wherein at least one of said plurality of notification messages includes modifying a dial tone of a telephone associated with the mailbox.” Further, with respect to claim 15, the Examiner appears to be taking Official Notice of the feature “wherein said modified dial tone includes changing the frequency of the dial tone.” Even further, with respect to claim 16, the Examiner appears to be taking Official Notice of the feature “wherein at least one of said notification messages includes stuttering the telephone dial tone.”

The MPEP mandates that “Official notice without documentary evidence to support an examiner’s conclusion is permissible only in some circumstances.” *Id.* “It would not be appropriate for the examiner to take official notice of facts without citing a prior art reference where the facts asserted to be well known are ***not capable of instant and unquestionable demonstration as being well-known.***” *Id.* (Emphasis added.) “For example, assertions of technical facts in the areas of esoteric technology or specific knowledge of the prior art must ***always be supported*** by citation to some reference work recognized as standard in the pertinent art. *In re Ahlert*, 424 F.2d at 1091, 165 USPQ at 420-21.” *Id.* (Emphasis added.) Applicants note that no such support has been provided in this case. Reviewing courts must rely on the record, and the Federal Circuit has always required that absent the case where Official Notice is “instant and unquestionable,” the Office Action must provide support and reasoning for Official Notice to be proper.

Applicants do not believe that the facts asserted as well-known in this case are capable of instant and unquestionable demonstration as being well-known. If the Examiner continues to believe that the above-recited features are well-known in the art, Applicants respectfully request that the Examiner provide a reference or references in

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the next Office Action allegedly offering evidence that this is the case. MPEP § 2144.03(C) instructs (with emphasis added):

If applicant adequately traverses the examiner's assertion of official notice, **the examiner must provide documentary evidence in the next Office action if the rejection is to be maintained.** See 37 CFR 1.104(c)(2). See also Zurko, 258 F.3d at 1386, 59 USPQ2d at 1697 ("[T]he Board [or examiner] must point to some concrete evidence in the record in support of these findings" to satisfy the substantial evidence test). If the examiner is relying on personal knowledge to support the finding of what is known in the art, the examiner must provide an affidavit or declaration setting forth specific factual statements and explanation to support the finding. See 37 CFR 1.104(d)(2).

The legal standard for applying Official Notice is rigorous, and Applicants respectfully submit that the present application of Official Notice falls short of meeting this high standard.

As shown above, Mohler does not teach or suggest all of the elements and features of these claims. Accordingly, Applicants respectfully request that the rejection be withdrawn.

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Conclusion

In view of the foregoing, Applicants believe that all claims now pending in this application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

Should the Examiner believe that a telephone conference would expedite prosecution of this application, please telephone or email me at your convenience.

Date: September 25, 2009,

Respectfully submitted,



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